

ESTTA Tracking number: **ESTTA309182**Filing date: **10/01/2009**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	PictureCode, LLC		
Entity	Limited Liability Company	Citizenship	Texas
Address	7610-B Highway 71 West Austin, TX 78735 UNITED STATES		

Attorney information	Katherine Klammer Madianos 3606 Enfield Road Austin, TX 78703 UNITED STATES katherine@madianoslaw.com Phone:512-569-3262
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**Registration Subject to Cancellation**

Registration No	3321797	Registration date	10/23/2007
Registrant	Melendez, Juan B. III 4280 Lindblade Dr. #104 Los Angeles, CA 90066 UNITED STATES		

**Goods/Services Subject to Cancellation**


Class 009. First Use: 2006/12/01 First Use In Commerce: 2007/05/01 All goods and services in the class are cancelled, namely: Children's educational music CDs and DVDs; Cinematographic film; Compact discs featuring Movies, Films, Commercials, Photos, Animation; Computer game discs; Computer game software; Computer programs for editing images, sound and video; Exposed camera film; Exposed cinematographic films; Game software; Interactive video game programs; Musical video recordings; Video discs featuring Movies, Films, Commercials, Photos, Animation; Video game software; Videotapes and video disks recorded with animation
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Non-Use on goods described in application; Bonaventure Associates v. Westin Hotel Co., 218 USPQ 537, Compton v. Fifth Avenue Ass'n, 47 USPQ2d 1300.

Related Proceedings	None.
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## Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77792169	Application Date	07/29/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NOISE NINJA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/10/17 First Use In Commerce: 2003/11/05 Computer programs for enhancing, editing and processing digital photographs and images		

Attachments	77792169#TMSN.jpeg ( 1 page )( bytes ) PetitiontoCancelDigitalNinjaFinal.pdf ( 8 pages )(38494 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Katherine K Madianos/
Name	Katherine Klammer Madianos
Date	10/01/2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 3,321,797	)	
Mark: DIGITAL NINJA	)	
Issued: October 23, 2007	)	
	)	
	)	
PICTURECODE, LLC,	)	Cancellation No. _____
	)	
Petitioner,	)	
	)	
v.	)	
	)	
JUAN B. MELENDEZ III	)	
	)	
Registrant	)	

**PETITION TO CANCEL**

PictureCode, LLC (“**Petitioner**”), a Texas limited liability company located and doing business at 7610-B Highway 71 West, Austin, Texas 78735, believes that it has been and/or will be damaged by Registration No. 3,321,797 for DIGITAL NINJA (the “**Registration**”), and hereby petitions to cancel the same under the provisions of 15 U.S.C. § 1064. To Petitioner’s knowledge, the owner of said Registration, Juan B. Melendez III (“**Registrant**”) has a current address of 4280 Lindblade Drive, Apartment 104, Los Angeles, California 90066-5899.

As grounds for cancellation, Petitioner asserts that:

1. Petitioner designs, builds and sells computer programs used to enhance, edit and process digital photographs and images. Since at least November 5, 2003, Petitioner has sold such software under its NOISE NINJA trademark in interstate commerce.
2. On April 9, 2009, Petitioner filed with the U.S. Patent and Trademark Office (the “**PTO**”) an intent-to-use trademark application (Serial No. 77/710439) (the “**Application**”) to register the mark PHOTO NINJA in international class 009 for the following goods: Computer

programs for creating, enhancing, editing, processing, manipulating, converting, viewing, browsing, managing, indexing, cataloging, sorting, organizing, storing, transferring, synchronizing, printing, and exchanging digital photographs and images; computer programs for creating web photo galleries and albums.

3. On July 7, 2009, Petitioner received an Office Action from the PTO examining attorney refusing to register PHOTO NINJA based on the examining attorney's belief that there is a likelihood of confusion between Petitioner's PHOTO NINJA mark and Registrant's DIGITAL NINJA mark, due to the similarity of the marks and because "the computer programs provided by the applicant and the registrant provide identical functions."

4. On July 29, 2009, Petitioner filed an application to register its NOISE NINJA trademark with the PTO (Serial No. 77/792169) for "computer programs for enhancing, editing and processing digital photographs and images" in international class 009, with a first use in commerce date at least as early as November 5, 2003.

5. Registrant filed the intent-to-use application that eventually matured into the DIGITAL NINJA Registration on July 26, 2006, under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(a) in international class 009 for the following goods: Children's educational music CDs and DVDs; Cinematographic film; Compact discs featuring Movies, Films, Commercials, Photos, Animation; Computer game discs; Computer game software; **Computer programs for editing images, sound and video**; Exposed camera film; Exposed cinematographic films; Game software; Interactive video game programs; Musical video recordings; Video discs featuring Movies, Films, Commercials, Photos, Animation; Video game software; Videotapes and video disks recorded with animation.

6. On June 19, 2007, Registrant filed with the PTO a Statement of Use in connection with this DIGITAL NINJA application, claiming use of the DIGITAL NINJA mark on or in connection with all goods listed in the application.

7. On October 23, 2007, based on the above described application, Registrant obtained U.S. Registration No. 3,321,797 on the principal register for DIGITAL NINJA in international class 009 for the goods listed in the application and set forth above.

8. Upon information and belief, although Registrant has claimed use of its DIGITAL NINJA mark as of June 19, 2007 on all 14 types of goods included in its application, Registrant has never used and is not using the mark in interstate commerce on or in connection with some or all such goods. Indeed, upon information and belief, Registrant is using and in the past has used the mark exclusively as a service mark for behind-the-scenes production, directing, editing, animation and related services for motion pictures, music videos and commercials, and not to identify the goods listed in its DIGITAL NINJA application or any other type of goods.

9. Specific to Petitioner's interests, upon information and belief, Registrant was not as of the filing date for its Statement of Use, and is not currently using, its DIGITAL NINJA mark on or in connection with "computer programs for editing images, sound and video."

10. Petitioner has been and will continue to be damaged by the existence of Registrant's DIGITAL NINJA Registration because (a) Petitioner's Application to register PHOTO NINJA has been refused due to Registrant's DIGITAL NINJA Registration, (b) Petitioner's application to register NOISE NINJA is likely to be refused due to Registrant's DIGITAL NINJA Registration, and (c) Registrant's DIGITAL NINJA mark is likely to cause confusion with Petitioner's senior NOISE NINJA mark.

First Basis for Cancellation -- Fraud

11. Petitioner realleges and incorporates herein by reference the paragraphs above.

12. Registrant's June 19, 2007, Statement of Use included a sworn declaration signed under penalty of perjury by Juan B. Melendez III, stating that Registrant was, as of such date, using its DIGITAL NINJA trademark in commerce "on or in connection with all goods . . . listed in the application or Notice of Allowance."

13. Upon information and belief, as of June 19, 2007, Registrant was not using, is not currently using, and has never used, the DIGITAL NINJA trademark in commerce on or in connection with some or all of the goods listed in its application.

14. Specific to Petitioner's interest, Registration was not, as of June 19, 2007 or at any time since then using its DIGITAL NINJA mark on or in connection with "computer programs for editing images, sound and video."

15. Upon information and belief, Registrant's claims of use in its Statement of Use were false at the time they were made.

16. Registrant's misrepresentation in its Statement of Use of the goods on which it was using its DIGITAL NINJA mark was a material misstatement of fact.

17. Upon information and belief, Mr. Melendez knew when he executed the Statement of Use that Registrant was not at that time using the DIGITAL NINJA trademark in commerce on or in connection with all of the goods listed in its application, including but not limited to "computer programs for editing images, sound and video."

18. Upon information and belief, said false statement was made knowingly and with the intent to deceive authorized agents of the PTO and induce them to grant the Registration.

19. Upon information and belief, reasonably relying upon the truth of Registrant's material false statements, the PTO did, in fact, grant the DIGITAL NINJA Registration to Registrant. Upon information and belief, the PTO would not have granted Registration No. 3,321,797 absent Registrant's knowingly false statements.

20. As such, the Registration was obtained fraudulently and should be cancelled and declared void ab initio.

#### Second Basis for Cancellation – Non-Use

21. Petitioner realleges and incorporates herein by reference the paragraphs above.

22. Upon information and belief, Registrant has never used its DIGITAL NINJA trademark in connection with some or all of the goods listed in its Registration.

23. Upon information and belief, Registrant's use of its DIGITAL NINJA mark has been solely in connection with behind-the-scenes production, directing, editing, animation and related *services* for motion pictures, music videos and commercials.

24. As such, the Registration was improperly granted and should be cancelled and declared void ab initio.

#### Third Basis for Cancellation – Abandonment

25. Petitioner realleges and incorporates herein by reference the paragraphs above.

26. As stated above, upon information and belief, Registrant has never used the DIGITAL NINJA trademark on or in connection with "computer programs for editing images, sound and video." However, even if Registrant did at some point use the DIGITAL NINJA trademark on such goods, upon information and belief, Registrant is not currently using its

DIGITAL NINJA trademark in commerce on or in connection with such goods, has made no such use for a period of several years, and has no bona fide intent to use its DIGITAL NINJA mark on or in connection with such goods in the future.

27. On information and belief, Registrant's DIGITAL NINJA mark has, due to its lack of use in connection with "computer programs for editing images, sound and video," lost all capacity as a source indicator for such goods.

28. As such, Registrant has abandoned its DIGITAL NINJA trademark with respect to "computer programs for editing images, sound and video."

#### Fourth Basis for Cancellation – Likelihood of Confusion

29. Petitioner realleges and incorporates herein by reference the paragraphs above.

30. As stated above, upon information and belief, Registrant has never used the DIGITAL NINJA trademark on or in connection with "computer programs for editing images, sound and video." However, if Registrant has used or is using its DIGITAL NINJA trademark on such goods, such use is likely to cause confusion with Petitioner's senior NOISE NINJA trademark.

31. Petitioner, since at least November 5, 2003, has been, and is now, using its inherently distinctive NOISE NINJA trademark in interstate commerce in connection with the sale of computer programs used to enhance, edit and process digital photographs and images. Said use has been valid and continuous since said date of first use and has not been abandoned. Petitioner's NOISE NINJA mark is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion.



32. On information and belief, Registrant made no use of its DIGITAL NINJA mark on or in connection with “computer programs for editing images, sound and video” in commerce prior to Petitioner’s first use in commerce of its NOISE NINJA mark. In fact, Registrant’s claimed first use of its DIGITAL NINJA mark anywhere, as set forth in its Statement of Use, is December 1, 2006, more than three years after Petitioner’s first use in commerce of its NOISE NINJA trademark.

33. In view of the similarity of Petitioner’s NOISE NINJA mark with Registrant’s DIGITAL NINJA mark, the overlapping and related nature of the goods in connection with which such marks are registered and/or used, and the fact that Petitioner’s use of its NOISE NINJA mark in interstate commerce was prior to any use by Registrant of its DIGITAL NINJA mark on computer programs for editing images, sound and video, Registrant’s DIGITAL NINJA mark is likely to cause confusion, or to cause mistake or to deceive consumers with respect to the following goods included in Registrant’s Registration: Computer programs for editing images, sound and video.

34. This likelihood of confusion and the resulting damage to Petitioner will continue until Registrant’s DIGITAL NINJA Registration is cancelled with respect to “computer programs for editing images, sound and video.”

**WHEREFORE**, Petitioner prays that Registration No. 3,321,797 be cancelled in its entirety because it was obtained by fraudulent representations to the United States Patent and Trademark Office and because Registrant has not used the mark on or in connection with some or all of the goods listed in its Registration. In the alternative, Petitioner prays that Registration No. 3,321,797 be cancelled in part, specifically with respect to “computer programs for editing images, sound and video” because: (1) the mark was never used by Registrant on or in connection with such goods, (2) if Registrant has ever made use of the DIGITAL NINJA mark on such

goods, said mark has been subsequently abandoned by Registrant with respect thereto, and/or (3) any use by Registrant of its DIGITAL NINJA mark on such goods is likely to cause confusion with Petitioner's senior NOISE NINJA trademark. Petitioner further requests such further relief as may be just and proper including its costs associated with this action.

Dated: October 1, 2009

Respectfully Submitted,

/Katherine K. Madianos/

Katherine Klammer Madianos, Esq.  
Attorney for Petitioner

**Certificate of Service**

Pursuant to C.R.F. § 2.111, I hereby certify that a true and correct copy of the foregoing Petition for Cancellation was served, via overnight courier, on the following:

1. Registrant Juan B. Melendez III, at the following address:

4280 Lindblade Drive, Apartment 104  
Los Angeles, California 90066-5899

2. Registrant's Attorney, Thomas T. Chan, at the following address:

P.O. Box 79159  
Los Angeles, CA 90079-0159

/Katherine K. Madianos/

Katherine Klammer Madianos, Esq.  
Attorney for PictureCode, LLC